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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,496	11/14/2003	S. Renee Starnes	16319-07385	1015
758	7590	08/11/2005	EXAMINER	
<b>FENWICK &amp; WEST LLP</b> SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041				BOVEJA, NAMRATA
		ART UNIT		PAPER NUMBER
		3622		

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/714,496	STARNES ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Namrata Boveja	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 November 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-26 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 November 2003 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

1. Claims 1-26 are presented for examination.

### ***Claim Rejections - 35 USC § 112***

The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

- (A) the claims must set forth the subject matter that applicants regard as their invention; and
- (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

2. Claim 19 is rejected under 35 U.S.C. 112.

Claims 19 recites the limitation "the monitor collecting the data" in line 5. There is insufficient antecedent basis for this limitation in the claim, since "the monitor" was not cited in previous claims.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement

thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the

issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the

patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

3. Claims 1-9 and 20-26 are rejected under 35 U.S.C. 101, because they do not apply, involve, use, or advance the technological arts. Specifically, claim 1 recites "displaying current amount of compensation" and "displaying a change in the amount of variable compensation," where no manipulation or calculation is being performed by the technology, and where a mere display of data does not advance the technological arts. In reference to claim 20, "collecting information" on the number of customer support calls received, the times the call center agent works, customer satisfaction information, and "calculating" a variable compensation amount are all steps that can be performed in the mind of the user or by the use of a pencil and paper, and therefore, do not advance the technological arts. Since claims 2-9 and 21-26 suffer from the same deficiencies,

they are herein rejected under a similar rationale as applied above to claims 1 and 20.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-8 and 19-26 are rejected under 102(b) as being anticipated by Berkson (Patent Number 6,049,779 hereinafter Berkson).

In reference to claim 1, Berkson teaches a computer implemented method of providing a customer service agent with variable compensation information (col. 2 lines 45-54), wherein the agent earns both fixed compensation and variable compensation for handling customer inquiries, the method comprising: displaying to the agent a current amount of variable compensation for the agent based on the agent's current performance level in handling customer inquiries (col. 3 lines 65 to col. 4 lines 4, col. 4 lines 52-65, col. 7 lines 15-34, col. 8 lines 24-32, col. 10 lines 41-48, and Figure 1); displaying to the agent a graphical user interface adapted to allow the agent to interactively change the agent's performance level (col. 8 lines 6-32 and Figure 1); and displaying to the agent a change in the amount of variable compensation based on the change in the agent's performance level (col. 7 lines 15-34, col. 10 lines 41-48, and Figure 1).

5. In reference to claim 19, Berkson teaches a computer implemented system for determining variable compensation for call center agents (col. 2 lines 45-54), the system

comprising: a telephone system including telephones to allow call center agents to provide help to customers over the telephones (col. 7 lines 35-48) and a workstation adapted for monitoring the call center agents' use of the telephones (col. 7 lines 42-54), the monitor collecting data including when the call center agents are logged on to the telephone system (i.e. tracking amount of time agent has worked) (col. 6 lines 62-67), how many calls the call center agents receive (col. 6 lines 38-41 and col. 9 lines 19-34), and whether the calls the call center agents receive are transferred by the call center agents to a customer feedback system (col. 4 lines 44 to col. 5 lines 16 and col. 8 lines 52 to col. 9 lines 12); a customer feedback system for receiving calls transferred by call center agents, and determining from the customers on the received calls a satisfaction level of the customers (col. 4 lines 26-65, col. 8 lines 52 to col. 9 lines 12, and col. 11 lines 56 to col. 12 lines 23); a call database connected to the telephone system for receiving and storing data indicative of how many calls the call center agents receive and whether the calls the call center agents receive are transferred by the call center agents (col. 6 lines 31-49, col. 7 lines 42-54, and col. 9 lines 4-12); a schedule database connected to the telephone system for receiving and storing data indicative of when the call center agents are logged on to the telephone system (i.e. tracking amount of time agent has worked, so this information must be stored in some type of a database) (col. 6 lines 62-67); a feedback database connected to the customer feedback system for receiving and storing data indicative of whether customers inquiries were resolved and the overall satisfaction of the customers for each call center agent (col. 7 lines 42-54, col. 8 lines 52 to col. 9 lines 12, and col. 11 lines 65 to col. 12 lines 4); a processor for

receiving information from the call database, the schedule database, and the feedback database and, based on the received information, calculating variable compensation (i.e. are “winnings” associated with playing games) for each call center agent (col. 3 lines 49-55, col. 4 lines 49-65, col. 6 lines 13-19, col. 8 lines 66 to col. 9 lines 4, and col. 10 lines 41-48); and a display tool for receiving the calculated variable compensation for a call center agent and displaying the variable compensation in real time to a call center agent (col. 3 lines 65 to col. 4 lines 4, col. 4 lines 52-65, col. 7 lines 15-34, col. 8 lines 24-32, col. 10 lines 41-48, and Figure 1).

6. In reference to claim 20, Berkson teaches a computer implemented method for determining variable compensation for a call center agent (col. 2 lines 39 to col. 3 lines 12), the method comprising: collecting information on the number of customer support telephone calls received (i.e. completed) by the call center agent (col. 6 lines 38-41 and col. 9 lines 19-34); collecting information on the times that the call center agent works (col. 6 lines 62-67); collecting customer satisfaction information of customers handled by the call center agent (col. 4 lines 44-65, col. 7 lines 28-34, and col. 9 lines 13-34); calculating, based on the collected information and in response to a received command, a variable compensation amount for the call center agent (col. 3 lines 65 to col. 4 lines 4, col. 4 lines 52-65, col. 7 lines 15-34, col. 8 lines 24-32, col. 10 lines 41-48, and Figure 1); and displaying the calculated variable compensation amount to allow the call center agent to determine the variable compensation (col. 3 lines 65 to col. 4 lines 4, col. 4 lines 52-65, col. 7 lines 15-34, col. 8 lines 24-32, col. 10 lines 41-48, and Figure 1).

7. In reference to claims 2 and 21, Berkson teaches the method, further comprising: determining the agent's current performance level as a function of customer satisfaction measure of the agent's handling of customer inquiries (col. 4 lines 44-65, col. 7 lines 28-34, and col. 9 lines 13-34).

8. In reference to claims 3 and 22, Berkson teaches the method, further comprising: determining the agent's current performance level as a function of the agent's compliance with a work schedule (col. 6 lines 62-67).

9. In reference to claims 4 and 23, Berkson teaches the method, further comprising: determining the agent's current performance level as a function of a number of customer inquires handled per time period (col. 6 lines 38-41 and col. 9 lines 19-34).

10. In reference to claims 5 and 24, Berkson teaches the method, further comprising: determining the agent's current performance level as a function of a measure of customer inquires resolved (i.e. problem solving success rate) by the agent (col. 8 lines 52 to col. 9 lines 12, col. 9 lines 19-34, and col. 11 lines 56 to col. 12 lines 23).

11. In reference to claims 6 and 25, Berkson teaches the method, further comprising: determining the agent's current performance level as a function of a rate of customer inquires transferred by the agent to a customer satisfaction survey system (col. 4 lines 44 to col. 5 lines 16 and col. 8 lines 52 to col. 9 lines 12).

12. In reference to claims 7 and 26, Berkson teaches the method, further comprising: determining the agent's performance in comparison with other agents in a cohort including the agent (col. 3 lines 13-30, col. 6 lines 31-67, and col. 11 lines 10-13).

13. In reference to claim 8, Berkson teaches the method, further comprising:  
displaying to the agent a minimum measure of performance (i.e. achievement of goals)  
for the agent to be eligible for the variable compensation (col. 7 lines 15-34 and lines 55  
to col. 8 lines 8, col. 9 lines 13-34, and col. 10 lines 41-47).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as  
set forth in section 102 of this title, if the differences between the subject matter sought to be  
patented and the prior art are such that the subject matter as a whole would have been obvious  
at the time the invention was made to a person having ordinary skill in the art to which said  
subject matter pertains. Patentability shall not be negated by the manner in which the invention  
was made.

14. Claims 9-18 are rejected under 35 U.S.C. 103 (a) as being unpatentable over  
Berkson.

Claims 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over  
Berkson in view of Gozdeck et al (Patent Number 6,636,852 hereinafter Gozdeck).

In reference to claims 10, Berkson teaches a computer implemented user  
interface for providing variable compensation information to agents (col. 3 lines 65 to  
col. 4 lines 4, col. 4 lines 52-65, col. 7 lines 15-34, col. 8 lines 24-32, col. 10 lines 41-48,  
and Figure 1), the user interface provided by a computer application executing on a  
computer system (Figure 1), the user interface comprising: a display window including a  
current performance measure for the agent (col. 7 lines 15-34, col. 10 lines 43-47, and  
Figure 1) and a current variable compensation amount based on the current

performance measure (col. 3 lines 65 to col. 4 lines 4, col. 4 lines 52-65, col. 7 lines 15-34, col. 8 lines 24-32, col. 10 lines 41-48, and Figure 1).

Berkson does not teach at least one interactive graphical element that is adapted to be directly manipulated by the agent to change the agent's current performance measure, wherein the current variable compensation amount is automatically adjusted in response to the change in the performance measure, even though Berkson does teach dispensation rules that describe variable payout (col. 10 lines 43-47). Gozdeck teaches at least one interactive graphical element (i.e. sales information) that is adapted to be directly manipulated by the agent (i.e. sales agent) to change the agent's (i.e. sales agent's) current performance measure, wherein the current variable compensation amount is automatically adjusted in response to the change in the performance measure (abstract, col. 2 lines 1-17, 40-45, and 61-to col. 3 lines 5, col. 5 lines 18-24 and 44-52, col. 8 lines 25-32, and Figures 1-3). It would have been obvious to modify Berkson to include at least one interactive graphical element that is adapted to be directly manipulated by the agent to change the agent's current performance measure, wherein the current variable compensation amount is automatically adjusted in response to the change in the performance measure to enable agents to better self-predict future performance and to maximize their payout by enabling agents to map up payout scenarios quickly and easily.

15. In reference to claim 11, Berkson teaches the user interface, wherein the current performance measure is a function of customer satisfaction measure of the agent's

handling of customer inquiries (col. 4 lines 44-65, col. 7 lines 28-34, and col. 9 lines 13-34).

16. In reference to claim 12, Berkson teaches the user interface, wherein the current performance measure is a function of the agent's compliance with a work schedule (col. 6 lines 62-67).

17. In reference to claim 13, Berkson teaches the user interface, wherein the current performance measure is a function of number of customer inquires handled per time period by the agent (col. 6 lines 38-41 and col. 9 lines 19-34).

18. In reference to claim 14, Berkson teaches the user interface, wherein the current performance measure is a function of a measure of customer inquires resolved (i.e. problem solving success rate) by the agent (col. 8 lines 52 to col. 9 lines 12, col. 9 lines 19-34, and col. 11 lines 56 to col. 12 lines 23).

18. In reference to claim 15, Berkson teaches the user interface, wherein the current performance measure is a function of a rate of customer inquires transferred by the agent to a customer satisfaction survey system (col. 4 lines 44 to col. 5 lines 16 and col. 8 lines 52 to col. 9 lines 12).

19. In reference to claim 16, Berkson teaches the user interface, wherein the current performance measure is a function of the agent's performance in comparison with other agents in a cohort including the agent (col. 3 lines 13-30, col. 6 lines 31-67, and col. 11 lines 10-13).

20. In reference to claim 17, Berkson teaches the user interface, wherein the display window further comprises a minimum measure of performance (i.e. achievement of

goals) for the agent to be eligible for the variable compensation (col. 7 lines 15-34 and lines 55 to col. 8 lines 8, col. 9 lines 13-34, and col. 10 lines 41-47).

21. Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berkson in view of official notice. In reference to claims 9 and 18, Berkson teaches the method and user interface comprising dispensation rules for prizes in that is explained or highlighted in the prize pool/bank and is accessible by the agents (col. 10 lines 43-47 and Figure 1) based on meeting performance parameters such as the rate of handling customer inquires and a measure of resolved inquires.

Berkson does not explicitly state the use of a payout grid, comprising a plurality of intersections, each intersection corresponding to a combination of a rate of handling customer inquiries and a measure of resolved inquiries, and associated with a variable payout factor. Official notice is taken that presenting data in visual format is well known in the area of sales and customer service, since this helps in communicating information quickly and effectively (i.e. listing out compensation figures as numbers has less of an impact than using a graph to show the difference between the figures or the trends in the data).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize some type of a payout grid or chart to visually indicate to the agents what variable compensation is available based on achieving certain performance milestones. Additionally, it is inherent that a chart or listing of some type (i.e. a table listing dispensation rules and type of prizes awarded based on levels of

performance) was anticipated by Berkson (col. 10 lines 43-47 and Figure 1) to simplify information presentation to the agents and to motivate the agents.

**Conclusion**

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure include the following.

- a) Business Wire. "First Tennessee Bank Selects Motiva to Manage Incentive Compensation." May 14, 2002. Pg. 1. Teaches a pay for performance system with dynamic changing and analytical capabilities.
- b) Gisby Patent Number 5,943,416. Teaches an automated survey control route in a call center environment.
- c) Maloney Patent Number 5,535,256. Teaches a method and system for automatically monitoring the performance quality of call center service representatives.
- d) M2 Presswire. "Witness Systems: Witness Systems announces new "mid-market" channel offering; Witness drives to attract the UK channel with customer interaction and performance evaluation software aimed at the small to medium sized contact centre market." May 7, 2002. Teaches eQuality Evaluation software that delivers customized graphs and reports.
- e) Sone Publication Number US 2003/182135 A1. Teaches a system and method for customer satisfaction survey and analysis for off-site customer service.

Any inquiry concerning this communication or earlier communications from

the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8105. On July 15, 2005, the Central FAX Number will change to **571-273-8300**. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

August 8, 2005

  
RETTA YEHDEGA  
PRIMARY EXAMINER